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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,838	09/30/2004	Shigetaka Kudou	SONYJP 3.3-993	2252
530 7590 01/05/2009 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090				
EXAMINER DINH, TAN X				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/509,838

Applicant(s)

KUDOU, SHIGETAKA

Examiner

TAN X. DINH

Art Unit

2627

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 4-9 and 12-22 is/are allowed.
- 6) ☒ Claim(s) 23-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

1) The amendment/Replacement sheets filed 10/10/2008 are acknowledged. Claims **2,3,10 and 11** have been canceled. New claims **17-41** are currently added.

2) The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3) Claims **36-41** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original fails to specify a computer-readable medium storing a computer-readable program and this program being operable to implement the steps of as recited in new claims 36-41. There is no computer-readable medium storing a computer-readable program has been disclosed in the original specification and this feature is considered as new matter.

4) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5) Claims **23-41** are rejected under 35 U.S.C. 103(a) as being unpatentable over **BERHAN (6,487,145)**.

BERHAN discloses a storing and reproducing apparatus, as claimed in claim 23, comprises a reproducing unit configured to reproduce main data and first management data for managing main data that are recorded in a first storage medium (Fig.3, CD changer 142; Fig.2B, CD reader 106), a storage unit configured to store into a second storage medium the main data and second management data for managing the main data to be stored in the second storage medium (Fig.3, Removable hard-disk unit 118), and a controller configured to control the storage unit to store the main data reproduced from first storage medium into second storage medium based on second management data, and to control storage unit to renew second management data based on the reproduction order of tracks stored in said first management data (Fig.3 Control panel 110), *except to specifically show the step of reproducing the main*

data in the reproduction order different from the reproduction order of tracks stored in first management data. However, to reproduce audio data in different order is old and widely used in audio recording/reproducing art (this technique is known as random playback. In this method the audio tracks/songs can be randomly playback in different order in TOC). Therefore, anyone of ordinary skill in the art at the time of the invention was made would have been motivated to apply random playback in BERHAN's audio player in order to play back the audio tracks in different order as claimed.

As to claim 24, the input from control panel for controlling the operation of the audio player is inherent in every audio player.

As to claim 25, the random number generator for generating random number during playback is inherent in most audio player.

BERHAN discloses all the subject matter as claimed in claim 27, *except to specifically shows that* when the main data is being reproduced from first recording medium which restricts to record main data into second recording medium. It would have been obvious matter of design choice to modify the BERHAN's audio recording by restricting the recording audio data into second medium during reading out from the first medium as claimed since

audio track, during recording or editing processes, can be selectively performed any desirable operations, such as, stopping the recording of any audio tracks, pausing, adding, deleting, etc.,.

As to claim 28, the divider means is inherent in BERHAN's audio recording device since the track on CD are divided and recorded separately on hard-disk.

Method claim(s) 29 is drawn to the method of using the corresponding apparatus claimed in claim 23. Therefore, method claims are rejected for the same reasons of anticipation (obviousness) as used above.

Claim 30 is rejected with the same reasons set forth in claim 24 above.

Claim 31 is rejected with the same reasons set forth in claim 25 above.

Claim 32 is rejected with the same reasons set forth in claim 26 above.

Claim 33 is rejected with the same reasons set forth in claim 27 above.

Claim 34 is rejected with the same reasons set forth in claim 28 above.

Claim 35 is rejected with the same reasons set forth in claim 23 above.

The features of claims 36-41 are not existed in the original disclosure, therefore, they are rejectable in view of claims 23-35 above.

6) Claims **1,4-9,12-22** are allowed.

7) Applicant's arguments with respect to claims **1-41** have been considered but are moot in view of the new ground(s) of rejection.

8) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN Xuan DINH whose telephone number is (571)272-7586. The examiner can normally be reached on Monday-Friday from 9:00AM to 5:00PM.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/TAN Xuan DINH/
Primary Examiner, Art Unit 2627
December 31, 2008